

Remarks:

Reconsideration of the application is requested.

Claims 2-5, 7-20, and 30-33 are now in the application.

Claims 2-5, 7-16, 18, and 20 have been amended. Claims 1 and 21-23 have been canceled. Claims 30-33 have been added.

In item 4 of the Office action, the Examiner objected to claim 4. More specifically, the Examiner objected to the penultimate paragraph and asked that it end with the word "and". Claim 4 has been amended so that the suggestion change is now moot.

In item 7 of the above-identified Office action, the Examiner has rejected claim 2 as being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, the Examiner point out that claim 2 did not clarify what was being controlled at a given frequency. Accordingly, claim 2 has been amended as suggested by the Examiner to clarify that the switch is being operated at a switching frequency.

In item 10 of the Office action, the Examiner rejected claim 4 as failing to comply with the written description requirement, under 35 U.S.C. § 112, first paragraph. Claim 4 has been amended. Claim 4 now reads, *inter alia*, "a minimum in a hertz

range." Support for this minimum is provided in the original specification at page 7, line 2 ("a few hertz").

Accordingly, the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-described changes to claims 2 and 4 are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In item 12 of the Office action, the Examiner rejected claims 1, 3-5, 7-12, 16, and 18-22 as being obvious over Harvey et al. (GB 1 447 754 A) in view of Matthews (GB 2 323 855 A), Welch (U.S. 4,209,552) and Goedicke et al. (WO 97/22988 A1) under 35 U.S.C. § 103(a). Claims 1 and 21-22 have been canceled. Claims 3-5, 7-12, 16, and 18-21, and 23 have been amended to depend ultimately on claim 2. Therefore, the rejection is now moot.

In item 14 of the Office action, the Examiner rejected claim 2 as being unpatentable over Harvey in view of Matthews and Welch. Claim 2 has been amended. Support for the change can be found in the specification at page 25, lines 1-3.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Amended claim 2 calls for, *inter alia*, a method that includes the following steps:

cleaning by generating a plasma with electrically positively charged ions, accelerating the ions towards the article, and bringing the ions into contact with the base body for cleaning the base body;

directing an electron beam of electrons onto the base body;

controlling an outgoing flow of the electrons coming into contact with the base body by connecting the base body to a reference potential via a switch at a given switching frequency;

coating the metallic base body;

continuing the cleaning step during at least a part of the coating step; and

selecting the given frequency from the group consisting of an adjustable frequency and a regulated frequency. (Emphasis added by Applicant.)

Harvey teaches that the cleaning effect is stopped during the coating step. In Harvey, in a first step, one switching frequency is used throughout the heating step, until equilibrium is reached. Harvey teaches that, in a second step, once equilibrium has been reached and deposition has started (see page 4, lines 27-33), the cleaning is stopped (see page 4, lines 34-39), and heating can continue (page 4, lines 45-51). Furthermore, in Harvey, step 2 has no frequency because it only heating via electron flow.

In contrast, the invention according to claim 2 calls for the cleaning/heating to continue at least during a part (if not all) of the coating step.

In addition, claim 2 of the instant application calls for the frequency to be an "adjustable frequency" or a "regulated frequency." A regulated frequency means that the process of cleaning/heating is controlled and the frequency is changed according to this anytime as necessary. In contrast, Harvey merely states, "It has been found advantageous to switch at a frequency of about one or two times per minute although shorter or longer periods can be used." In other words, Harvey teaches to use a given, set frequency in the range throughout the heating. Accordingly, Harvey does not teach or suggest every feature of claim 2.

Accordingly, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 2. Therefore, claim 2 is patentable over the art. Moreover, because all of the dependent claims are ultimately dependent on claim 2, they are believed to be patentable as well.

New claim 32 should be entered and is patentable over the prior art for the following additional reasons. First, support for claim 32 can be found in the originally-filed

specification: continuous regulating of the switching frequency is described in the specification at page 7, lines 7-17; especially lines 11-13. Claim 32 calls for the frequency to be regulated continuously. In contrast, Harvey uses a frequency that is never adjustable, but merely set; see Harvey page 2, lines 98-105. Therefore, claim 32 is not taught or suggested by Harvey.

In view of the foregoing, reconsideration and allowance of claims 2-5 and 7-20, and 30-33 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$410 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

LOREN DONALD PEARSON
REG. NO. 42,987



For Applicant

LDP:cgm

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Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

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